

REMARKS

Summary of the Claims

With the present Office Action, and after entry of the above amendments, claims 15-31 are pending in the Application. Claims 29-31 stand rejected under 35 U.S.C. § 102. Claims 15-28 stand rejected under 35 U.S.C. § 103(a). All rejections are traversed.

Amendments to the Claims

Claims 21 and 29 have been amended, without prejudice, to address minor grammatical informalities. No new matter has been introduced to the application and the scope of the claims has not been changed.

Telephonic Interview Summary

A telephonic interview was conducted on April 1, 2008. Those present at the interview were Examiner Estrada and the Applicant's representative Adam J. Citrin. During this interview, the Applicant's right to claim priority, the double patenting objection, and the prior art documents were discussed. Examiner Estrada and Adam Citrin reached agreement on all issues discussed, as will be explained in more detail below. The Applicant's representative would like to thank Examiner Estrada for his time and for the courtesies extended during the interview.

Priority

The Office Action stated that the Applicant was not entitled to the benefit of the priority date of U.S. Provisional Patent Application No. 60/549,714, though the Office Action provided no details as to which features of the claims were alleged to lack support under 35 U.S.C. § 112. As such, the subject of priority was discussed during the telephonic interview referenced above.

During the interview, the Examiner and the Applicant's representative examined the claims. After lengthy discussion and careful examination of the

priority documents, it was demonstrated by the Applicant's representative, and agreed to by the Examiner, that each feature of the claims was disclosed in the priority documents.

For example, it was stated that the Priority document disclosed "conduit," but did not disclose cables. The Applicant's representative noted that while the application is directed to, *inter alia*, a "Conduit Manager," that page 1 of the provisional application states, in pertinent part, that "the term 'conduit' used herein, including the claims, includes all manner of cords, cables, lines, wires, hoses, filaments, pipes, tubes, ribbons, tape...." The remainder of the application is directed to, *inter alia*, systems and methods for protecting rigid and flexible conduit (as defined in the specification) and power strips. The Examiner agreed that power cables and power strips were included in the Provisional Application.

The claimed "manifold" was also discussed. It was noted that the Provisional Application disclosed "a manifold for providing a protective cover..." It was noted that the Provisional Application describes the "manifold" as "any chamber or device," including the teaching that "the apparatus could marry to itself and encapsulate the entire power strip..." with more details disclosed in the application. The Provisional Application also explains that the apparatus "may be made of a flexible heat and flame resistant material...[such as] flame resistant canvas..." The power strip is also disclosed in the Provisional Application in numerous places.

Substantially all of the features of the claims were addressed during the interview and it was agreed that all of the claimed features were disclosed and taught in the priority document. As such, it was agreed that the Applicant is entitled to the benefit of the priority date of the Provisional Application.

Double Patenting

The double patenting objection was briefly discussed. It was noted that claims 15 and 21 recite different features. For example, claim 21 recites, *inter*

alia, child resistance features. Claim 15 does not recite child resistance features. While "child resistant securing means" can be included in the scope of "securing means," it will be understood that "securing means" are not necessarily included in the scope of "child resistant securing means."

Since the scope of claims 15-20 differs from the scope of claims 21-26, as explained above, claims 15-20 and 21-26 do not "cover the same thing, despite a slight difference in wording."

Rejections Over the Prior Art

Rejections Under 35 U.S.C. § 102

Claims 29 and 30 have been rejected as anticipated over U.S. Pat. No. 4,944,694 to Dorn ("Dorn").

While the Applicant does not concede that Dorn teaches the other cited features of claim 29, the Applicant specifically notes that Dorn does not teach at least the claimed feature of "a child-resistant means for securing [the manifold] portions in a closed position." In fact, Dorn is completely silent as to locking his apparatus, and never mentions children, youth, or the like. It is known that every claimed feature must be disclosed in a cited document to demonstrate a *prima facie* case of anticipation under 35 U.S.C. § 102. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)(holding that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.).

Since Dorn does not teach at least the feature of child resistance, Dorn does not anticipate the invention claimed in claim 29. Since claim 30 depends from claim 29, claim 30 is patentable over Dorn for at least the reason cited above. As such, the Applicant respectfully submits that the rejection of claims 29 and 30 over Dorn should be withdrawn.

Claims 29-31 have been rejected as anticipated over U.S. Pat. Pub. No. 2006/0065422 to Broyles ("Broyles").

While the Applicant does not concede that Broyles anticipates the claimed subject matter, it is noted that the subject matter of this application claims priority to a provisional application filed on March 3, 2004. Broyles was filed on Jan. 28, 2005 and claims priority back to a provisional application filed on September 27, 2004. As such, Broyles reference is not prior art under 35 U.S.C. § 102(e), since the Broyles application was not "filed in the United States before the invention by the applicant." 35 U.S.C. § 102 (2007).

Therefore, the Applicant respectfully submits that the rejection under 102(e) over Broyles must be withdrawn.

Claim Rejections Under 35 U.S.C. § 103

Claims 15, 21, and 27 are rejected under 35 U.S.C. § 103 over Dorn. Dorn is cited as teaching many features of the claims.

With respect to claims 21 and 27, it is noted that Dorn does not teach or suggest at least the feature of child resistance, as explained above with respect to claim 29.

With respect to each of the rejected claims, the Office Action concedes that Dorn does not teach or suggest the use of fire-resistant material, as claimed by the Applicant. In attempting to address this noted deficiency, the Office Action states that "it would have been obvious...to make at least one part of said manifold constructed of fire resistant material..." *Office Action*, Page 5. The Office Action cites *In re Leshin* as providing support that substituting the materials cited by Dorn with a fire-resistant material would be an "obvious design choice." *In re Leshin*, states that "selection of a *known material on the basis of suitability for the intended purpose* is a matter of obvious design choice." 125 U.S.P.Q. 416 (C.C.P.A. 1960)(emphasis added).

There is no evidence in Dorn or in any of the cited references that fire-resistant material was a *known material* for purposes of constructing conduit

management apparatuses. Furthermore, there is no evidence in the record, other than the present application, that fire-resistant material would be *suitable for the intended purpose* of constructing a conduit management apparatus. As such, there is no proof in the record for the statement that fire resistant material would have been an obvious design choice for the applicant's claimed apparatus. Therefore, *In re Leshin* supports patentability of the claims, contrary to the position taken in the Office Action.

The Applicant notes that the mere statement that an invention would have been obvious, without any support from the record or any of the references, is insufficient to maintain a rejection under 35 U.S.C. § 103. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (BPAI 1993)(holding that rejections on obviousness cannot be sustained by mere conclusory statements...); *M.P.E.P.* § 2143.01 (8th ed. rev. 6, Sep. 2007). The Office Action provides no support for the proposition that fire-resistant materials were *known* in the art of conduit management apparatus manufacturing, and that such fire-resistant materials were *suitable* for use in making conduit management apparatuses.

Therefore, the Applicant respectfully submits that the rejections of claims 15, 21, and 27 are unsupported by evidence and should be withdrawn.

Claims 15-28 are rejected under 35 U.S.C. § 103 over Broyles.

As noted above, Broyles is not prior art under 35 U.S.C. § 102. Since Broyles is not prior art under 35 U.S.C. § 102, Broyles is not an effective reference for purposes of 35 U.S.C. § 103.

Therefore, the Applicant respectfully submits that the rejections under 35 U.S.C. § 103 over Broyles must be withdrawn.

CONCLUSION

It is respectfully submitted that all of the claims are in condition for allowance and notice to that effect is hereby requested. Should any new concerns arise, Examiner Estrada is urged to please initiate a telephone

interview with the undersigned representative to expedite prosecution of the present application.

There are no fees believed due with the filing of this paper. If there are any fees resulting from this communication, please charge same to our Deposit Account No. 50-3447.

Respectfully Submitted,
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